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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

FORSELL, Peter

Atty. Ref.: 2333-139

Serial No. 10/530,015

TC/A.U.: 3746; Conf. No. 7845

Filed: September 26, 2005

Examiner: Gilbert, Samuel G.

For: IMPLANTABLE PUMP FOR OPERATION OF HYDRAULIC IMPLANT

\* \* \* \* \*

October 26, 2009

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

In response to the September 25, 2009 Office Action in the above-identified application subjecting this application to an election/restriction requirement, applicant hereby elects the claims of Group I (i.e., claims 1-31 and 35-113) for further prosecution in this application.

With regard to the Examiner's contention that the present application also includes several species shown in Figures 1-3, Figure 4, Figures 5-7, Figure 8 and Figure 9 of the present application, and his additional requirement that Applicant elect one of these species for further prosecution in this application, Applicant contends that the figures of the application identified by the Examiner do not disclose different species because such figures do not show all of the same elements, much less alternative embodiments of all of the same elements. See the discussion regarding generic and

species claims in *Mechanics of Patent Claim Drafting* (Second Edition) by John L. Landis, attached as Attachment A.

Nevertheless, in response to the requirement in the election/restriction set forth in the outstanding Office Action, Applicant elects, with traverse, the Species of Figures 1-3 for further examination in this application. Applicant contends that claims 1-14 and 35 read on these figures. Because these figures do not show a surgical implant, as recited in claim 15 and alternative to the embodiment of the surgical implant shown in Figure 4 of the present application, Applicant believes that claim 15 is not generic to Figures 1-3 of the present application.

It is believed that no fee for filing this Response to Election/Restriction Requirement is due. However, the Commissioner is hereby authorized to charge any deficiency in the fee that may be due to the deposit account of Nixon & Vanderhye, Account No. 14-1140.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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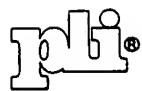
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Patent, Copyright, Trademark and Literary Property  
Practice Handbook Series  
Number 4

MECHANICS OF  
PATENT CLAIM  
DRAFTING  
*(Second Edition)*

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With the Collaboration of  
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G1-0633  
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Library of Congress Catalog Card Number: 74-77345

**SUMMARY**—Use Jepson-type claims extensively for improvement type inventions, where new or modified elements are added to an otherwise old and unchanged combination. Describe the old elements from the closest single reference in the preamble. Usually the old things can be described fairly broadly. Describe the new or modified elements in the body of the claim after a transition such as “wherein the improvement comprises,” or “the improvement comprising.” Connect or relate the new elements to each other and to the preamble elements, as with any other claim, particularly in mechanical combination (machine) claims as outlined in Chapter II.

### Section 55—Generic and Species Claim

In some inventions, there are two or more alternative and mutually exclusive embodiments of the invention; that is, where two or more different structures, steps, parts or compounds, called “species,” may be used interchangeably to accomplish a desired result. Examples of this are the legs and springs in Figs. 2 and 3 of Example I (Appendix A); the copper, silver or aluminum stripe of the resistor in Section 47; the separation of alcohol from a water solution by fractional distillation or by solvent extraction in Section 34. A generic claim is one which defines the element in question with sufficient breadth to cover all of the disclosed species, and often also additional undisclosed species, while the species claims cover the separate embodiments one at a time. Note that, if no allowable generic claim is presented, a requirement for restriction among disclosed species is likely, called “election of species.” 35 U.S.C. §121 and rules 141, 142 and 146. After election, all claims readable on the species are examined.

If no concrete generic word is apparent, a means-plus-function clause may be appropriate to provide a generic expression, as outlined in Section 31. In chemical cases, a Markush group is always a generic expression, as discussed in Section 47. Of course,

alternative expressions cannot be used to make a generic claim, as set out in Section 21, except under the new Markush practice in Section 47.

There is no special problem in drafting generic and species claims. The species claims may be either dependent or independent, although the dependent claim form is especially useful and common in this situation. One makes an element of the generic claim more specific in one way for species I and in a different way for species II.

The words genus and species, in most cases, signify relative to a particular set of claims; a generic expression (electrically conductive metals) may be a species of a more generic expression (electrically conductive materials, which also includes carbon). The words genus and species in patent law can be totally arbitrary such as genus: mammals; species: man, cat, etc.—but genus: man; species: male, female. The breakdowns are made in whatever way suits the invention. Some species, which cannot practically be further divided (sodium chloride) are referred to as "ultimate species." In mechanical cases, there would theoretically never be an ultimate species because an element (a spring for example) could be a species of biasing means, but would be generic to particular kinds of springs (coil springs, leaf springs), and each of these could be further defined in parallel, mutually exclusive ways.

These distinctions are not too significant as far as writing claims is concerned. They relate primarily to the question of whether one can obtain one patent (with an allowable generic claim) or several patents (in most cases where no allowable generic claim is presented).

**SUMMARY**—Generic claims cover two or more mutually exclusive species, A or B, and possibly also C or D, etc., not all of which may be disclosed. Claims to the individual species cover less than the whole group of things, either one at a time, or less than all at one time. There are no special problems in writing such claims. Such claims may come up in any statutory class of utility invention: machine, process, article of manufacture, or composition of matter.

**FINGERPRINT CLAIM**—A claim defining a chemical COMPOSITION in terms of its properties, such as X-ray diffraction, solubility, melting point, phase diagram, spectrum, etc., often as shown in the drawing. The use of such a claim is limited to emergency situations wherein the differences between the INVENTION and the PRIOR ART cannot be explained or described (and claimed) in the traditional terms of physical or chemical structure. Such a claim must, nevertheless, distinctly claim the INVENTION. See Sections 49, 50 and 51. (49, 50, 51)

**FORM/FORMAT OF CLAIMS IN GENERAL**—Chapter II and Section 10.

**FORMAL REJECTION**—A REJECTION (OBJECTION?) made by the EXAMINER to the form, as opposed to the substance (novelty and/or unobviousness), of a claim. A NON-ART REJECTION. See Chapter IX. (Chapter IX, 57, 64)

**FULLY MET**—A phrase used to REJECT a claim which is completely anticipated by or shown in a single REFERENCE. This type of REJECTION is properly posited on 35 U.S.C. 102, not on 35 U.S.C. 103.

**FUNCTION/FUNCTIONAL CLAUSE/LIMITATION** — Describing an ELEMENT in terms of what it does, as opposed to what it is (i.e., its structure). See Section 27. At times a FUNCTIONAL LIMITATION may be expressed negatively, that is, by what the ELEMENT does not do. (27, 28, 30, 31, 42, 46, 60, 64)

**FUNCTIONAL ORDER**—A logical ordering of the ELEMENTS of a claim which begins with the ELEMENT which first contacts the WORKPIECE. See STRUCTURAL ORDER and Section 24.

**GAZETTE**—See OG/OFFICIAL GAZETTE.

**GENERIC/GENUS**—A GENUS is a class BROADER than, or

including, more than one SPECIES. "Primate" is a GENUS with respect to "man" and "ape" which are SPECIES thereof. A GENERIC claim includes within its SCOPE two or more disclosed embodiments (SPECIES). Such a claim must cover or READ ON what is comprehended in each of the SPECIES. See MPEP 806.02(d) and (e), and Section 55. (12, 16, 21, 31, 33, 42, 46, 47, 48, 55)

**GERUND**—A verbal noun expressing the action of the verb in a generalized manner; a verbal noun, ending in "-ing" and performing the function of a substantive, often taking the case phrase construction, and at the same time showing the verbal features of tense and voice, taking adverbial modifiers, and governing objects. Usually, GERUNDS are the first words of METHOD steps, the basic ELEMENTS of a METHOD claim. See Section 33.

**HAS/HAVING**—TRANSITION words between the PREAMBLE and the BODY of a claim. Mean the same as COMPRISES/COMPRISING. (7, 54)

**HOLE**—Absence of material. HOLES, unlike most ELEMENTS, should usually be claimed INFERENTIALLY (Sense (1)), as "a lever having a hole." See Section 23. (22, 23, 31)

**IMPROVEMENT CLAIM**—Section 54.

**INCLUDES/INCLUDING**—TRANSITION words between the PREAMBLE and BODY of a claim. Mean the same as COMPRISES/COMPRISING. (7, 54)

**INCOMPLETE**—Quality of a claim which omits essential ELEMENTS or cooperative relationships. See MPEP 706.03(f) and Section 63. (56, 63, 64, 65)

**INDEFINITE**—(1) Lack of proper ANTECEDENT. (2) The quality of a claim which fails to accurately define the limits or